



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,309	01/22/2004	Henry B. Strub	345288015US	8261
25996 7590 09/05/2008 PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247				
EXAMINER CHEVALIER, ROBERT				
ART UNIT		PAPER NUMBER		
2621				
MAIL DATE		DELIVERY MODE		
09/05/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/764,309

**Applicant(s)**

STRUB ET AL.

**Examiner**

ROBERT CHEVALIER

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40-51 and 54-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-51 and 54-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 40-51, 54-58 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 40-51, 54-58, are rejected under 35 U.S.C. 103(a) as being unpatentable over McNelley et al (P.N. 5,550,754) in view of Olofsson (P.N. 4,380,024).

McNelley et al disclose a portable video phone system that shows substantially the same limitations recited in claims 40, and 51, including the feature of obtaining a first set of visual data associated with the event using a first recording unit (See

McNelley et al's Figure 8, where it is shown a video phone means having the capability of obtaining and recording visual data of a surrounding area), the feature of obtaining a second set of visual data associated with the event using a second recording unit, the second recording unit being physically separate from the first recording unit (See the capability of establishing a video telephone conversation between a first party and a second party as shown in McNelley et al's claim 1, lines 1-4; therefore, the two parties in conversation can be obtaining and recording visual data of the same surrounding area while they are disposed at a distance between each other), and the feature of transmitting the first set of visual data to the second recording unit as specified in the present claims 40, and 51. (See McNelley et al's column 22, lines 41-51).

McNelley et al fails to specifically disclose the feature of marking a specified time and associating a predetermined meaning to the marking using the first recording unit as specified in the present claims 40, and 51.

Olofsson discloses a camera system which includes the capability of mixing video data with specialized marking data before recording the mixed video data on the recording medium as specified in the present claims 40, and 51. (See Olofsson's Figure 5, components 25, 30, and the corresponding disclosure).

It would have been obvious to one skilled in the art to modify the McNelley et al's apparatus wherein the video recording means provided thereof would incorporate the capability of mixing the video data with specializing marking data before recording the same on the recording medium in the same conventional manner as is shown by

Olofsson. The motivation is to facilitate the identification of the recorded video data as suggested by Olofsson.

With regard to claim 41, the feature of displaying the first set of visual data on the recording medium as specified thereof would be present in cited reference of McNelley et al. (See McNelley et al's column 22, lines 19-22).

With regard to claims 42-43, the feature of transmitting wirelessly the first set of visual data to the second recording unit as specified thereof is present in McNelley et al. (See McNelley et al's column 7, line 66, to column 8, line 9).

With regard to claim 44, the feature of transmitting an identifier indicating an origin of the first set of visual data as specified thereof is present in the proposed combination of McNelley et al and Olofsson. (See McNelley et al's claim 15, and Olofsson's Figure 5, components 25, and 30, and the corresponding disclosure).

With regard to claim 45, the feature of storing the first and second set of visual data as specified thereof is present in McNelley et al. (See the capability of recording visual data from both parties as shown in McNelley et al's claim 15, and claim 17, lines 1-8).

With regard to claim 46, the feature of selectively storing one of the two sets of visual data as specified would be present in McNelley et al. (See the capability of recording visual data from both parties as shown in McNelley et al's claim 15, and claim 17, lines 1-8, and the recording controller shown in McNelley et al's Figure 8, component 188).

With regard to claim 47, the feature of the visual data being compressed as specified thereof is present in McNelley et al. (See McNelley et al's column 18, lines 43-48).

With regard to claims 48, 56, the feature of coordinating between the first and second recording units to sync the first and second set of visual data as specified thereof would be present in McNelley et al. (See the capability of recording visual data from both parties as shown in McNelley et al's claim 15, and claim 17, lines 1-8, and the recording controller shown in McNelley et al's Figure 8, component 188).

With regard to claims 49, 58, the feature of transmitting audio data from one of the recording units to the other as specified thereof is present in McNelley et al. (See McNelley et al's column 23, lines 6-9).

With regard to claim 50, the feature of displaying the first set of visual data on the second recording unit and switching to display the second set of visual data on the second recording unit as specified thereof is present in McNelley et al. (See McNelley et al's column 22, lines 19-22).

With regard to claims 54-55, 57, the feature of the meaning indicating the beginning or ending of an activity of interest, or the level of importance, or geographical information, as specified thereof is noted to a present characteristic of the proposed combination indicated above. Because, Olofsson already discloses that the user can always mark the video with any type of desired comments. (See Olofsson's column 4, line 39).

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ROBERT CHEVALIER** whose telephone number is (571)272-7374. The examiner can normally be reached on **MM-F (9:00-6:30)**, second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT CHEVALIER/  
Primary Examiner, Art Unit 2621  
September 1, 2008.